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08/702,525

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/702,525	02/07/97	SHARPE	A
			BWI-120CPUS
			EXAMINER

18M1/0722

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BOSTON MA 02109

GAMBLER	PAPER NUMBER
ART UNIT	
1806	

DATE MAILED: 07/22/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.
- A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-76 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-76 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ NOTICE TO COMPLY WITH SEQUENCE RULES
- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Serial No. 08/702525  
Art Unit 1806

### DETAILED ACTION

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821-1.825. However, this application fails to comply with the requirements set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant is required to fulfill these requirements by defining the SEQ ID NOS in both the specification and claims.

The following procedure is to be used for cases that contain the same sequence disclosure as the parent. The applicant need not submit a new computer readable form of the Sequence Listing in this rule 60 continuation. However, (1) the specification must contain a paper copy of the Sequence Listing, (2) applicant must request in writing that the CRF in the parent case be used to prepare a file for the offspring and (3) applicant must submit a statement that the paper copy of the Sequence Listing in the offspring is identical to the computer readable form submitted in the parent case.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-17, 30-31, 63-65, 69-71 and 75-76, drawn to B7-1-specific nucleic acids, and expression vector and host cells, classified in Class 536, subclass 23.1 and 23.5 and Class 435, subclasses 69.1, 70.1, 71.1, 172.1 and 320.1.

II. Claims 18-29, 66-68 and 72-74, drawn to B7-1-specific proteins, classified in Class 530, subclass 350, 395.

III. Claims 32 and 62, drawn to B7-1-specific antibodies, classified in Class 530, subclass 387.1.

IV. Claims 33-47 and 60-61, drawn to B7-2-specific nucleic acids, and expression vector and host cells, classified in Class 536, subclass 23.1 and 23.5 and Class 435, subclasses 69.1, 70.1, 71.1, 172.1 and 320.1.

V. Claims 48-59, drawn to B7-2-specific proteins, classified in Class 530, subclass 350, 395.

VI. Claim 62, drawn to B7-2-specific antibodies, classified in Class 530, subclass 387.1.

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3. Inventions I/II/III/IV/V/VI are different products. Nucleic acids (and vectors and host cells), proteins and antibodies are distinct because their structures and modes of action are different. Furthermore, the B7-1 and B7-2 specificities are distinct as they relate to different products and functions of those products. Therefore they are novel and unobvious in view of each other and are patentably distinct.
4. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-VI is not required for any other group from Groups I-VI and Groups I-VI have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.
5. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee can be reached on (703) 308-2731. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1800 receptionist whose telephone number is (703) 308-0196.

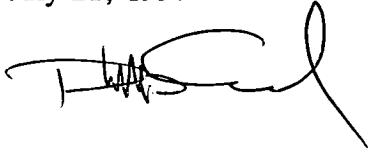
Papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014 or (703) 308-4242. (703) 305-7939.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lila.feisee@uspto.gov].

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Phillip Gambel, PhD.  
Patent Examiner  
Group 1800  
July 21, 1997

A handwritten signature in black ink, appearing to read "P. Gambel", with a large, stylized loop at the end.

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING  
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 CFR 1.821 - 1.825. Applicant's attention is directed to these regulations, published at 1114 OG 29, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ 7.

Other: \_\_\_\_\_

**Applicant must provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing"
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification
- ☐ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d)

For questions regarding compliance with these requirements, please contact:

For Rules Interpretation, call (703) 308-1123

For CRF submission help, call (703) 308-4212

For PatentIn software help, call (703) 557-0400

Please return a copy of this notice with your response.